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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,939	11/03/2003	Hiroyuki Ishida	Q77928	5053
23373	7590	05/30/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			LEE, Y MY QUACH	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/698,939

Applicant(s)

ISHIDA, HIROYUKI

Examiner

Lee Y Quach

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8, 11, 15 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 12-14 and 17 is/are rejected.
- 7) ☒ Claim(s) 3-5, 9, 10 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2875

### ***DETAILED ACTION***

#### ***Response to Arguments***

1. Applicant's arguments filed April 24, 2006 have been fully considered but are moot in view of the new ground(s) of rejection in light of "the optical axis of the light emitting device" and the arguments regarding the "optical axis" of Chen et al. The finality of the previous action is therefore withdrawn. The indicated allowability of claim 14 is withdrawn and the rejection of claims 12, 13 and 17 is maintained in view of the newly discovered reference to Shiu. Rejections based on the newly cited reference follow.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of "an optical axis of said light emitting device" as claimed in claim 3, "said optical axis of said light emitting device" and "a center axis of said device lens" as claimed in claim 4, "said optical axis of said light emitting device" as claimed in claim 5, "the semiconductor light emitting device has a single optical axis" as claimed in claim 12, and "the optical axis of said device lens corresponds to a single optical axis for the semiconductor light emitting device" as claimed in claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 2875

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to because it is not clear what is considered to be the optical axis of the semiconductor light emitting device or the semiconductor light emitting device having a single optical axis? While drawing figure 4 shows an optical axis of the lens 13 but the drawings do not show the optical axis or single optical axis of the semiconductor light emitting device.

***Claim Objections***

4. Claims 9 and 10 are objected to because of the following informalities: In claim 9, the language “a center axis of said lens of said light emitting device” is inaccurate. Should it be “a center axis of said lens of said optical system”? Claim 10 depends on objected claim 9 and as such is also objected. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. Claims 3 to 5, 12 to 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, it is not clear how can the semiconductor light emitting device has an optical axis by merely having at least one semiconductor light emitting element for forming a first illuminating beam and at least one semiconductor light emitting element for forming a second illuminating beam without optical element(s)? Claim 5 depends on rejected claim 3 and as such is also rejected.

In claim 4, it is not clear what is the difference between “said optical axis of said light emitting device” and “a center axis of said device lens”?

In claims 12 and 14, it is not clear how can the semiconductor light emitting device has a single optical axis by merely having at least one semiconductor light emitting element for forming a first illuminating beam and at least one semiconductor light emitting element for forming a second illuminating beam without optical element(s)? Claim 13 depends on rejected claim 12 and as such is also rejected.

In claim 16, it is not clear what is the difference between “the optical axis of said device lens” and “a single optical axis of the semiconductor light emitting device”?

Art Unit: 2875

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 12 to 14 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiu.

Shiu shows an optical system comprising at least one of a reflector (26) and a lens (18), a semiconductor light emitting device comprising at least one semiconductor light emitting element (24b) for forming a first illumination beam and at least one semiconductor light emitting element for forming a second illuminating beam (24a to 24c), wherein the illumination beams are switchable by selectively activating selected ones of the light emitting elements for forming the first and second illuminating beams (column 4, lines 34 to 37), a device lens (30) covering and immediately adjacent to the at least one semiconductor light emitting element for forming the first illuminating beam and the at least one semiconductor light emitting element for forming the second illuminating beam, the at least one semiconductor light emitting element for forming a first illuminating beam and the at least one semiconductor light emitting element for forming a second illuminating beam within a connected volume defined below the device lens (figures 2 and 3), the semiconductor light emitting device having a single optical axis (the optical axis of the lens 30), and the at least one semiconductor light emitting element for forming a first illuminating beam and the at least one semiconductor light emitting element for forming a second illuminating beam emitting light along the single optical axis.

8. Claims 3 to 5 and 16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. Claims 6 to 8, 11, 15, and 18 to 20 are allowed.

10. Claims 9 and 10 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

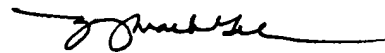
Art Unit: 2875

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 571-272-2373. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service 571-272-2815.

Y. Q.  
May 18, 2006



Y Quach Lee  
Primary Examiner  
Art Unit 2875